

REMARKS

Claims 1, 2, 6-9, 11-25 and 29-42 are rejected. Claims 26-28 and 43 have been withdrawn. Claim 1 has been amended. Claims 1, 2, 6-9 and 11-42 are presently pending in the application. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

The basis for the amendment of claim 1 is found on pg. 3, lines 3-4, and pg. 12, line 31 of the specification as originally filed.

Rejection on the Ground of Non-Statutory Double Patenting

The Examiner has provisionally rejected Claims 1, 2, 6-9, 11-25 and 29-42 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 and claims 1-54 respectively of copending Application Nos. 10/271,082 and 10/271,057. The Examiner has also rejected Claims 1, 2, 6-9, 11-25 and 29-42 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,866,902. The Examiner has provisionally rejected Claims 1, 2, 6-9, 11-25 and 29-42 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of copending Application No. 10/118,697. Timely filed terminal disclaimer, according to 37 CFR 1.321(c), relating to Application Nos. 10/271,082, 10/118,697, and 10/271,057 and U.S. Patent No. 6,866,902 are attached and are believed to overcome the rejection. Reconsideration is requested.

Rejection Under 35 U.S.C. §102(b):

The Examiner has rejected Claims 1, 2, 6-9, 19-25, 34, 35 and 38 under 102(b) as being anticipated by Okumura et al. (US 5,360,780) for reasons of record and for reasons given below.

Okumura discloses an image-receiving sheet for thermal transfer printing comprising a substrate and an image-receiving layer disposed on said substrate, characterized in that said image-receiving layer contains thermoplastic resin fine particle aggregates.

The present invention relates to an inkjet recording element comprising a support and at least two ink receiving layers thereon, wherein the topmost of said at least two ink receiving layers comprises porous polyester particles, wherein at least 68% of said porous polyester particles have a diameter

of less than 0.5 micrometers. These particles, when used in coatings provide enhancements in the gloss, ink dry time and dye retention of the coating.

A claim is anticipated under 102(a) only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Okumura fails to disclose that the topmost layer contains porous polyester particles, 68% of which have a diameter of less than 0.5 micrometers. In addition, the present invention claims an inkjet recording element comprising a support having thereon an ink receiving layer capable of accepting an inkjet image. Okumura fails to mention inkjet recording elements or ink receiving layers capable of accepting inkjet images, teaching instead thermal transfer printing elements.

The Examiner indicates that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). There is a known structural difference between a thermal transfer printing element and an inkjet receiving element. A thermal transfer printing element is not capable of functioning as an inkjet receiving element. In an inkjet receiving element, the ink is in a carrier solvent which penetrates rapidly into the receiving layer. The colorant is carried by a solvent. In thermal transfer receiving elements, dye melts or diffuses into the receiver, (Okumura, col. 1, lines 62-68) but is not carried by a solvent. Ink carried by a solvent, when applied to a thermal receiving element does not wet the element properly and does not form the desired image (see Exhibits 2 and 3), especially as compared to an inkjet receiving element (Exhibit 1). The reverse is also true. An inkjet receiver printed with a thermal donor (Exhibit 5) does not produce the desirable image produced when a thermal donor is printed to a thermal receiver (Exhibit 4). Therefore, the receiving elements are not interchangeable and a thermal receiver is not capable of performing as an inkjet

receiver. See attached Fourth Declaration of Landry-Coltrain and attached Exhibits 1-5. Therefore, the rejection should be withdrawn.

The Examiner indicates that Applicant's arguments filed December 17, 2005 have been fully considered but they are not persuasive, as they are not directed to the reference but to another thermal print paper, the composition of the paper layers is not disclosed so no direct comparison can be made with the applied prior art to determine if it is representative of the applied art, and there are numerous ink jet ink formulations that are designed to be used with a specific paper and give better results with that specific paper. Applicants do not disclose this composition either. Applicants statements illustrate that thermal receiver and inkjet receiver differ. The Applicant has provided a Fifth Declaration of Landry-Coltrain, which provides the composition of the thermal receivers and inkjet receivers utilized in the Exhibits. Finally, the imaging elements were provided to illustrate that inkjet formulations do not provide a desirable image when applied to thermal receivers and thermal formulations do not provide desirable images when applied to inkjet receivers, thus, indicating a functional and structural difference between the two types of receivers.

Rejection Under 35 U.S.C. §103(a):

The Examiner has rejected Claims 1, 2,6-9, 11-25, 33-39, 41 and 42 under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (5360780) for reasons set forth above and for the following reasons.

The reference Okumura cited by the Examiner comprises non-analogous art. In order to rely on a reference as a basis for rejection of Applicant's invention, a reference must either be in the field of the Applicant's endeavor or reasonably pertain to the particular problem with which the invention is concerned. Here, the cited reference is not in Applicant's field of endeavor, that is, the reference is not an inkjet recording element. Instead, Okumura relates to a thermal recording element. Patent and Trademark Office Classification is some evidence of analogy, but similarities and differences in structure and function carry more weight. MPEP 2141.01(a). The Okumura and the present application are contained in different classifications. Okumura is contained in U.S. Class 503/227 (Record receiver having plural interactive leaves or a colorless color former, method of use, or developer therefore / HAVING PLURAL INTERACTIVE LEAVES). The present application is contained in

U.S. Class 428/32.34 (STOCK MATERIAL OR MISCELLANEOUS ARTICLES / Particles (e.g., pigment, etc.) present in ink receptive layer). Critical differences exist in function between Applicant's invention and the cited reference to Okumura. The invention of Okumura is utilized in conjunction with a donor sheet that applies colorant to the thermal receiver by melting, evaporating or sublimating colorant by the application of heat. Unlike the reference, the present invention functions to absorb solvent-borne ink. Pg. 1, lines 16-21). Further, there are important structural differences between the present invention and the prior art which are evidence of non-analogousness. For example, to operate properly, the invention of Okumura is used in conjunction with a color transfer sheet. The receiving layer of Okumura receives dyes. As indicated above, the dyes are disclosed as colorants which melt, evaporate or sublime. The present invention is printed upon with an inkjet printer and is absorbent of ink. Since the cited reference and the present invention are contained in different Classifications, serve a different purposes and function and contain distinct structural differences, the Applicants respectfully suggest that the reference to Okumura is non-analogous art, and do not support a rejection based on obviousness.

Assuming for argument, that the cited reference of Okumura is analogous art, to establish a prima facie case of obviousness requires, first, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.


Okumura fails to mention the use of a distribution of particles of mean diameter less than 0.5 micrometers of which 68% of the particles have a diameter of less than 0.5 microns and fails to mention the use of these particles to enhance the gloss of a coated inkjet layer. In fact, Okumura teaches use of particles in a thermal transfer receiving sheet. Okumura also fails to produce a reasonable expectation of success, as Okumura fails to mention that particles of size less than 0.5 micrometers prove useful in increasing gloss or providing an inkjet coating with increased gloss. It would not be obvious to one of ordinary skill in the art would recognize that the materials useful in thermal transfer

receiving layers would function properly in inkjet layers, let alone improve the gloss. Finally, Okumura fails to teach all of the limitations of the present claims as it fails to teach or disclose the use of particles of less than 0.5 micrometers and fails to mention that in a distribution of particles of mean diameter less than 0.5 microns, more than 68% have a particle size of less than 0.5 microns to produce high gloss coatings. As a result, Okumura fails to support a prima facie case of obviousness under 35 U.S.C. 103(a).

The present invention also provides surprising results. Not only does the present invention improve the gloss, but it also improves ink dry time and dye retention at the same time it improves the gloss. (See Table 5, pg. 28) While it may be known in the art to improve gloss, dry time and dye retention individually, it is not known that the use of particles of less than 0.5 micrometers, or the use of an ink receiving layer with porous particles, in which 68% of the porous particles have will produce high gloss coating, which exhibit improved ink dry time and dye retention. The ability to improve all three properties at once is surprising. In light of these surprising results, the Applicants request that the Examiner reconsider and withdraw the rejection.

It is believed that the foregoing is a complete response to the Office Action and that the claims are in condition for allowance. Favorable reconsideration and early passage to issue is therefore earnestly solicited.

Respectfully submitted,


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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.